

Application No. 10/654,661
Response to Office Action of September 14, 2005

REMARKS/ARGUMENTS

Claims 1-64, 87-94, and 104-105 are cancelled. Claims 106-110 are new. Support for the new claims is found throughout the specification and at originally filed Claims 100 and 95-99. Claims 68, 70, 72, 74, 82, 85, and 100 are amended. Support for the amendment to Claim 100 is found at original Claim 65. Support for the amendment to Claim 85 is found at page 37, line 15, of the original specification. Support for the amendment to Claim 82 is found at page 36, line 9, of the original specification. Support for the amendment to Claim 74 is found at page 30, line 15, of the original specification. Support for the amendment to Claim 72 is found at page 33, line 12, of the original specification. Support for the amendment to Claim 70 is found at page 23, line 19, of the original specification. Support for the amendment to Claim 68 is found at page 24, line 8, of the original specification. No new matter is believed to be introduced by the amendments and the newly added claims.

Claims 65-86, 95-103, and 106-110 are pending. Favorable reconsideration is respectfully requested in light of the Remarks below.

The rejection of Claims 1-105 under the judicially created doctrine of obviousness double patenting over pending Claims 1-29 of copending US patent Application No. 10/384,075 is traversed below.

Examiner Acquah so kindly indicated that the rejection is provisional. Applicants kindly direct the Office's attention to the PAIR system indicating that a Petition to Withdraw from Issue has been granted for Copending US patent Application No. 10/384,075. Therefore, prosecution of Claims 1-29 of copending US patent Application No. 10/384,075

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remains open. Accordingly, Applicants kindly request that the rejection be held in abeyance until at least one set of claims in the present case or Claims 1-29 of copending US patent Application No. 10/384,075 issue in a US patent.

The objections of Claims 28, 39, 41, 68, 70, 72, 74, and 75 are believed to be obviated by the amendment above. Accordingly, withdrawal of this ground of rejection is respectfully requested.

The rejection of Claims 52 and 53 under 35 U.S.C. § 112, second paragraph, is believed to be obviated by the amendment above. Accordingly, withdrawal of this ground of rejection is respectfully requested.

If, in fact, the word "Monomer" as it stands alone is deemed by the office to be indefinite and/or confusing when used in a claim, Applicants respectfully disagree. The word "Monomer" is accepted by those skilled in the art, the EPA and Pine Chemicals Association to be a distinct and unique composition. The specification, at pages 46, line 26, to page 48, line 21, clearly defines Monomer, even providing a CAS number for guidance as an example. In light of this more than two pages provided to describe the word "Monomer", Applicants contend that everyone, including those skilled in the art, can clearly understand the definition of Monomer if/when used in claims. Applicants respectfully submit that this description of Monomer provided in the specification would obviate future questions regarding the word "Monomer's definiteness/clarity when used in the claims.

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The rejection of Claims 1-105 under 35 U.S.C. §102(b) over Bender et al. (US'932) is traversed below. Claims 1-64 have been cancelled.

US'932 relates to a phenolic resin-modified natural resinic acid esters, as well as methods of making and using the same (See abstract). When characterizing the phenolic compounds that are to be used according to US'932 to make its resinic acid ester, US'932 specifically states:

"In respect of B) The phenols described above in connection with the prior art can be used. Preferred phenols are monofunctional and difunctional, in particular difunctional, phenols, i.e. those in which one or two of the ortho- or para-positions with respect to the phenolic OH group on the benzene ring are reactive and capable of aldehyde addition. Trifunctional phenols, such as, for example, phenol, or tetrafunctional phenols, such as, for example, diphenylolpropane, can also be used in minor amounts together with monofunctional and/or difunctional phenols, in which case the proportion of trifunctional or tetrafunctional phenols should preferably not be more than 20% by weight, based on the total amount of phenols employed." (bold added, See column 6, lines 41-64, of US'932).

Accordingly, while US'932 discloses that trifunctional phenols, such as phenol, may be used, US'932 discloses that they must be used in minor amounts because the monofunctional and difunctional phenols must be present as the majority amount of the total phenol employed. More specifically, US'932 discloses that *trifunctional or tetrafunctional phenols should preferably not be more than 20% by weight, based on the total amount of phenols employed*. Accordingly, US'932 teaches that the use of phenolic compounds where

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trifunctional or tetrafunctional phenols are more than 20% by weight, based on the total amount of phenols employed, is undesirable.

In direct contrast, the present invention is related, in part, to a process for preparing a resin by reacting reactants at elevated temperature, the reactants being, in part, a rosin, fatty acid, aldehyde and phenolic compound that is at least trifunctional with respect to reactivity with aldehyde as well as resins, varnishes, and inks made therefrom. In the present invention, the phenolic compound that is at least trifunctional constitutes at least 25 wt% of all phenolic compounds used to form the resin (See Claim 65 and 100).

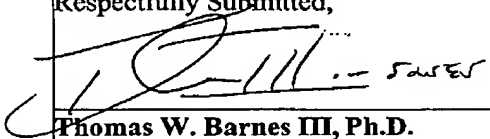
In light of the above, US'932 can not possibly disclose, much less suggest, the claimed invention. This is because the present invention relates, in part, to a resin made from a phenolic compound where a phenolic compound that is at least trifunctional constitutes at least 25 wt% of all phenolic compounds used to form the resin. US'932 not only fails to disclose the present invention, it actually teaches away from present invention by disclosing that the use of phenolic compounds where trifunctional or tetrafunctional phenols are more than 20% by weight, based on the total amount of phenols employed, is undesirable (see discussion above). Accordingly, US'932 neither discloses, nor suggests the claimed invention.

Applicants respectfully submit that the present application is now in condition for allowance. Favorable reconsideration is respectfully requested. Should anything further be

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required to place this application in condition for allowance, the Examiner is requested to contact below-signed by telephone.

Please charge the amount of \$1020.00 required for the request for extension of time to our Deposit Account No. 09-0525. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 09-0525. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time.

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